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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/309,130	05/10/1999	MICHAEL E. RAKAUSKAS	28572/32531A	7131

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ROPES & GRAY
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BOSTON, MA 02110-2624

EXAMINER

KRUER, KEVIN R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding..

Advisory Action

Application No.

09/309,130

Applicant(s)

RAKAUSKAS 

Examiner

Kevin R Kruer

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 17-25 and 37-49.Claim(s) withdrawn from consideration: NONE.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Advisory Action

Applicant's arguments filed January 9, 2004 have been fully considered but are not persuasive. Furthermore, Applicant's claim amendments will not be entered because they do not comply with the requirements of 37 CFR 1.121. Specifically, claim 50 is listed as pending but was canceled in the amendment filed February 20, 2002, but is listed as pending in the current listing of the claims. Furthermore, claim 18 is currently pending, but is indicated as canceled on the listing of claims.

Applicant argues that kraft paper crossbanding materials are not an embodiment of Baymiller reference, and the only discussion of kraft paper in Baymiller is for the express purpose of teaching that kraft paper is not suitable in the disclosed invention. The examiner initially notes the Baymiller does not teach that kraft paper crossbanding material is not suitable. Rather, Baymiller teaches that such crossbanding materials are inferior. Furthermore, MPEP 2123 states that the use of patents as references is not limited to what the patentees describe as their own invention, and can be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. While Baymiller's invention is drawn to the use of felt impregnated crossbanding sheets, the disclosure of Baymiller reasonably suggests to one having ordinary skill in the art that kraft paper crossbanding materials may be utilized (col 1, lines 30-37). Specifically, Baymiller teaches that impregnated kraft sheets have previously been used in the art as crossbanding materials. Thus, Applicant's arguments are not persuasive.

Art Unit: 1773

Applicant further argues that McClain, Guyette, Booker, Carter, and Sunol, fail to cure the deficiencies of the Baymiller reference regarding the use of a kraft paper crossbanding sheet. However, none of the references were relied upon for such a teaching. Baymiller, as described above, was relied upon to teach the use of kraft paper crossbanding materials.

With respect to McClain, Applicant argues that the reference does not teach that warpage can be prevented by applying an impregnated sheet on the non-veneered surface of a substrate. However, the examiner notes that it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. Thus, Applicant's arguments are not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.

K-RK

Kevin R. Kruer
Patent Examiner-Art Unit 1773

Paul Thibodeau
Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700